

**REMARKS**

By this Amendment, Applicant has amended claim 1. No new matter has been added. Claims 1-25 are present in the application and pending on the merits. Applicant respectfully requests reconsideration and withdrawal of the claim rejections included in the Office Action of October 23, 2008 ("the Office Action"), for at least the reasons outlined herein.

As an initial matter, Applicant appreciates the Examiner's reconsideration and withdrawal of the claim rejections under 35 U.S.C. § 103(a) based in part on U.S. Pat. App. Pub. No. 2003/0177952 to Cummings et al. included in the Office Action dated April 22, 2008. Further, Applicant appreciates the Examiner's indication that claim 5 recites allowable subject matter. Office Action at 14. For at least the reasons outlined herein, Applicant believes that all of pending claims 1-25 are patentably distinguishable from the prior art of record in this application.

**I. Rejection of Claims under 35 U.S.C. § 103(a) based on Johns and Willis**

In the Office Action, claims 1-4 and 6-13 were rejected under 35 U.S.C. § 103(a) based on WO 02/16511 to Johns et al. ("Johns"), either alone or in combination with U.S. Patent No. 5,169,443 to Willis et al. ("Willis"). Office Action at 2. Claim 1 is the only independent claim included in that claim rejection, and by this Amendment, Applicant has amended independent claim 1. Applicant respectfully submits that amended independent claim 1 fully complies with 35 U.S.C. § 103(a) for at least the reasons outlined herein.

Applicant's independent claim 1 is directed to a pigment product including, *inter alia*, "kaolin having a particle size distribution such that . . . from greater than 10% to about 20% by weight of the particles have an equivalent spherical diameter less than about 0.25  $\mu\text{m}$  . . ." Applicant respectfully submits that neither Johns nor Willis discloses at least this subject matter recited in Applicant's independent claim 1.

The rejection statement asserts that "[w]ith reference to the limitation of about 10-20% having a particle size of less than about 0.25 $\mu\text{m}$ , it is noted that the instant claim recites 'about 10%', and the word 'about' has not been defined in the specification of the instant application and thus permits some tolerance." Office Action at 3. Thus, the rejection statement concedes that Johns does not disclose a particle size distribution such that . . . from greater than 10% to about 20% by weight of the particles have an equivalent spherical diameter less than about 0.25  $\mu\text{m}$ . (Emphasis added.) Indeed, Johns expressly discloses "not more than 10% by weight has a particle size less than 0.25  $\mu\text{m}$ ." See, e.g., Abstract (emphasis added). Thus, Johns does not disclose at least this subject matter recited in independent claim 1. Willis does not supply this missing subject matter.

For at least the above-outlined reasons, Johns and Willis, regardless of whether they are viewed individually or as a whole, do not render Applicant's independent claim 1 *prima facie* obvious. Further, Applicant continues to believe that independent claim 1, in the form prior to the amendment included herein, is patentably distinguishable from Johns and Willis for at least the reasons outlined in Applicant's Request for Reconsideration filed July 9, 2008. Therefore, Applicant respectfully

requests reconsideration and withdrawal of the rejection under § 103(a) of independent claim 1 based on Johns, either alone or in combination with Willis.

**II. Claim Rejection under § 103(a) based on Johns, Willis, Hiorns, and Yuan**

Claims 20-25 were rejected under 35 U.S.C. § 103(a) based on either Johns in combination with U.S. Patent No. 6,284,034 to Hiorns et al. ("Hiorns") and U.S. Patent No. 6,402,826 to Yuan et al. ("Yuan"), or on Johns in combination with Willis, Hiorns, and Yuan. Office Action at 6. Claims 20-25 depend from independent claim 1. Thus, dependent claims 20-25 should be allowable for at least the same reasons independent claim 1 is allowable. Further, neither Hiorns nor Yuan supply the subject matter recited in independent claim 1 that is neither disclosed nor rendered obvious by the hypothetical combination of Johns and Willis. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection under § 103(a) of claims 20-25 based on Johns, Willis, Hiorns, and Yuan.

**III. Claim Rejection under § 103(a) based on Johns, Willis, and Husband**

Claims 14-16 and 18 were rejected under 35 U.S.C. § 103(a) based on either Johns in combination with WO 99/51815 to Husband et al. ("Husband"), or on Johns in combination with Willis and Husband. Office Action at 8. Claim 14 is the only independent claim rejected under 35 U.S.C. § 103(a) based on the above references, and Applicant respectfully traverses that rejection because the combination of references fails to disclose or render obvious all of the subject matter recited in independent claim 14. See M.P.E.P. § 2141 (8th ed. rev. 7 July 2008). In particular,

the rejection statement's hypothetical modification to the kaolin particulate material disclosed in Johns is contrary to the express teachings of Johns.

Under 35 U.S.C. § 103(a), several basic factual inquiries must be made in order to evaluate whether a patent claim is obvious. According to the M.P.E.P., obviousness is a question of law based on these factual inquiries. § 2141(II) (citing KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 82 U.S.P.Q.2d (BNA) 1385 (2007), and relying on the framework established by Graham v. John Deere Co., 383 U.S. 1, 17, 148 U.S.P.Q. (BNA) 459, 467 (1966)). In particular, the Graham factual inquiries create a four-part framework for evaluating whether a patent claim is obvious. Graham, 383 U.S. at 17. Those factual inquiries are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims at issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

Id. The M.P.E.P. advises that the question of obviousness must be resolved on the basis of these factual determinations. M.P.E.P. § 2141(II).

The M.P.E.P. also provides guidelines for making these factual determinations. For example, the M.P.E.P. cautions that in order to avoid impermissible hindsight reasoning, these factual determinations must be made with respect to "the time the invention was made." § 2141.01(III). Moreover, the M.P.E.P. cautions that when "determining the differences between the prior art and the claims, the question [of obviousness] is not whether the differences themselves would have been obvious, but [rather, it is] whether the claimed invention as a whole would have been obvious."

§ 2141.02(I). Indeed, when considering the prior art, “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” § 2143.03(VI) (second emphasis added).

Once the Graham factual inquiries have been resolved, it must be determined whether a claim is *prima facie* obvious. § 2141(III). Following the guidance of the above-outlined framework, the M.P.E.P. cautions that in order to establish a *prima facie* case of obviousness, “the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made.” § 2142. Further, “the examiner must then make a determination whether the claimed invention ‘as a whole’ would have been obvious at that time to that person,” and further, that “[k]nowledge of applicant’s disclosure must be put aside in reaching this determination” because “impermissible hindsight must be avoided and a legal conclusion must be reached on the basis of the facts gleaned from the prior art”; not on the basis of applicant’s disclosure. Id.

Based on this guidance, the M.P.E.P. advises “[i]f a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” § 2143.01(VI). In other words, if the prior art teaches away from a proposed modification, then the prior art does not render a claim *prima facie* obvious.

Applicant respectfully traverses the § 103(a) rejection of independent claim 14 because the proposed combination of the Johns, Willis, and Husband references fails to support a *prima facie* case of obviousness that satisfies either the Graham factual

inquiries or the standard for *prima facie* obviousness set forth in the M.P.E.P. In particular, Applicant respectfully submits that Johns teaches away from the rejection statement's proposed, hypothetical modification to the Johns kaolin particulate material based on Willis and Husband.

Applicant's independent claim 14 is directed to "[a] method of making a pigment product comprising a steep, platy kaolin having a particle size distribution such that . . . from about 15% to about 20% by weight of the particles have an equivalent spherical diameter less than about 0.25  $\mu\text{m}$  . . ." For reasons similar to those outlined above with respect to the rejection of independent claim 1 under § 103(a) based on Johns and Willis, Johns and Willis do not disclose or render *prima facie* obvious at least this subject matter recited in independent claim 14. Indeed, Johns expressly discloses that "not more than 10% by weight has a particle size less than 0.25  $\mu\text{m}$ ." See, e.g., Abstract (emphasis added). Thus, Johns does not disclose at least this subject matter recited in independent claim 14. Willis does not supply this missing subject matter.

The rejection statement asserts that Husband discloses a "coating composition comprising processed kaolin having a particle size distribution such that . . . not less than 12% by weight of the particles have a size of less than 0.25  $\mu\text{m}$ ." Office Action at 9. Without providing any legally sufficient rationale in purported support, the rejection statement apparently asserts that it would have purportedly been obvious to modify the kaolin particulate material of Johns based on Husband's disclosure, such that the kaolin of Johns would have a particle size distribution, such that from about 15% to about 20% by weight of the particles have an equivalent spherical diameter less than about 0.25  $\mu\text{m}$ ," as recited in Applicant's independent claim 14.

Applicant respectfully disagrees with the apparent obviousness assertion at least because such a proposed, hypothetical modification to the Johns kaolin particulate material is contrary to the express teachings of Johns. In particular, Johns expressly discloses a kaolin particulate material, such that "not more than 10% by weight has a particle size less than 0.25  $\mu\text{m}$ ." Abstract (emphasis added). Thus, modifying the Johns kaolin particulate material, such that from about 15% to about 20% by weight of the particles have an equivalent spherical diameter less than about 0.25  $\mu\text{m}$ , is contrary to the express teachings in Johns.

According to the M.P.E.P., when considering the prior art, "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." § 2143.03(VI) (second emphasis added). Applicant respectfully submits that under the express guidance of the M.P.E.P., and based on the express teachings of Johns, which expressly teach away from the rejection statement's hypothetical modification to the Johns kaolin particulate material, Applicant's independent claim 14 is not *prima facie* obvious based on Johns, Willis, and Husband, regardless of whether those references are viewed individually or as a whole. For at least this reason, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claim 14 under § 103(a) based on Johns, Willis, and Husband.

Moreover, Applicant respectfully submits that the rejection statement fails to explain why the differences between Johns, Willis, and Husband and the subject matter recited in independent claim 14 would have been obvious to one of ordinary skill in the art for at least the reasons outlined below. For at least the reason outlined above, Applicant respectfully submits that neither Johns nor Willis nor Husband discloses or

renders obvious at least the above-noted subject matter recited in Applicant's independent claim 14. Because the rejection statement has failed to explain why at least this difference between Johns, Willis, and Husband and the subject matter recited in independent claim 14 would have been obvious to one of ordinary skill in the art, Applicant respectfully requests reconsideration and withdrawal of the § 103(a) rejection of independent claim 14 based on those references.

For example, the rejection statement asserts that with respect to independent claim 14, "Johns et al. alone or in view of Willis et al., as set forth above teach kaolin product that meets the claimed size requirements alone [sic] with the claimed shape factor and steepness requirements." Office Action at 8. Applicant respectfully submits that that the rejection statement has misinterpreted Johns and/or Willis by alleging that these references disclose the above-mentioned subject matter. Indeed, Johns discloses "wherein the kaolin of the product suspension . . . is such that . . . not more than 10% by weight has a particle size less than 0.25  $\mu\text{m}$ ." Abstract; pp. 2-3, lines 30-3. Further, claim 11 of Johns, which is referenced the rejection statement relating to independent claim 1, clearly indicates that the percentage of kaolin with a particle size less than 0.25  $\mu\text{m}$  is "not more than 10[%]." Likewise, Willis discloses a kaolin pigment product with a particle size distribution where "12% or less [are] finer than 0.2 micrometers." Col. 3, line 16. Finally, Husband does not supply the subject matter not disclosed in either Johns or Willis. While Husband discloses a process of forming a pigment product with less than 35% of the product having a particle size of less than 0.25  $\mu\text{m}$ , Husband does not disclose, suggest, or render obvious, such a size

distribution with the claimed shape factor and steepness requirements. See Abstract; pp. 8-9.

For at least the above-outlined reasons, Applicant's independent claim 14 is not *prima facie* obvious based on Johns, Willis, and Husband, regardless of whether those references are viewed individually or as a whole. Therefore, Applicant respectfully requests reconsideration and withdrawal of the § 103(a) claim rejection based on those references.

**IV. Rejections of Dependent Claims 17 and 19 under § 103(a)**

Claim 17 was rejected under 35 U.S.C. § 103(a) based on either Johns in combination with Husband and U.S. Patent No. 6,003,795 to Bown et al. ("Bown"), or on Johns in combination with Willis, Husband, and Bown. Office Action at 9. Claim 19 was rejected under 35 U.S.C. § 103(a) based on either Johns in combination with Husband and U.S. Patent No. 5,089,056 to Shi et al. ("Shi"), or on Johns in combination with Willis, Husband, and Shi. Office Action at 11. Claims 17 and 19 depend from independent claim 14. Thus, dependent claims 17 and 19 should be allowable for at least the same reasons independent claim 14 is allowable. Further, neither Bown nor Shi supply the subject matter recited in independent claim 14 that is neither disclosed nor rendered obvious by the hypothetical combination of Johns, Willis, and Husband. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejections under § 103(a) of claims 17 and 19 based on Johns, Willis, Husband, Bown, and Shi.

V. Conclusion

For at least the reasons set forth above, independent claims 1 and 14 should be allowable. Dependent claims 2-13 and 15-25 each depend from a corresponding one of those allowable independent claims. Consequently, those dependent claims should be allowable for at least the same reasons as the corresponding allowable independent claim. Accordingly, Applicant respectfully requests reconsideration of this application, withdrawal of the claim rejections, and allowance of all of pending claims 1-25.

If the Examiner believes that a telephone conversation might advance prosecution, the Examiner is cordially invited to call Applicant's undersigned attorney at (404) 653-6561.

Applicant respectfully submits that the Office Action contains a number of assertions concerning the related art and the claims. Regardless of whether those assertions are addressed specifically herein, Applicant respectfully declines to automatically subscribe to them.

Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our Deposit Account 6-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: February 20, 2009

By:   
Matthew T. Nesbitt  
Reg. No. 57,734